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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,659	09/29/2003	Michael Gomer Stelljes JR.	9372	2454

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THE PROCTER & GAMBLE COMPANY  
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EXAMINER
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LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/673,659

Applicant(s)

STELLJES ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 10-23,25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-9 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 and 24 of copending Application No. 10/950706 as presented in the last office action, mailed August 3, 2006. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite non-adhesively bonded embossed sites and adhesively bonded non-embossed sites.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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3. Claims 1-9 and 24 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/225946 as presented in the last office action, mailed August 3, 2006. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite non-adhesively bonded embossed sites and the other bond site can be considered the adhesively bonded non-embossed sites. The examiner notes application 11/225946 is a division of the instant application, however, the claims have been amended and the instant claims would be subject to a double patenting rejection as indicated above due to said amendment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The applicant indicated in the last response, filed November 2, 2006, that terminal disclaimers were filed over both the above applications, however, none has been received in the file as of preparation of this office action.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claim 24 is rejected under 35 U.S.C. 102(b) as being anticipated by Donnelly (3708366) as presented in the office action, mailed August 3, 2006.

Donnelly discloses an embossed multiply sheet wherein the first face comprises non-adhesively bonded embossed sites (top protrusion section just to the right of 9' which can be considered the top of the embossment) and adhesively bonded non-embossed sites at 13 (i.e. a valley portion). Refer to figure 3, which is substantially the same as applicant's figure 1A. Refer to column 3, line 70 through column 4, line 2 disclosing that the embossed sites are non-adhesively bonded, even if it is quite low for normal moisture content webs and more adhesion is provided if the moisture content is about 20%. Also refer to column 3, line 26 through column 4, line 36.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly in view of Ruppel et al. (5846636) as presented in the last office action, mailed August 3, 2006.

Donnelly discloses an embossed multiply sheet wherein the first face comprises non-adhesively bonded embossed sites (top protrusion section just to the right of 9' which can be considered the top of the embossment) and adhesively bonded non-embossed sites at 13 (i.e. a valley portion). Refer to figure 3, which is substantially the same as applicant's figure 1A. Refer to column 3, line 70 through column 4, line 2 disclosing that the embossed sites are non-adhesively bonded, even if it is quite low for normal moisture content webs and more adhesion is provided if the moisture content is about 20%. Also refer to column 3, line 26 through column 4, line 36. Donnelly also teaches the embossments are at least 1000 $\mu$ m. Refer to column 3, lines 39-45 which disclose the frustum that form the embossment is 0.035-0.050 inches high (i.e. 899 $\mu$ m-1270 $\mu$ m). Donnelly does fail to specifically disclose the less than 30% adhesive bond

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area. Donnelly is silent as to the percent coverage, however, does disclose the adhesive is applied in small discrete amounts in order to avoid final product stiffening (column 3, lines 58-60). This examiner believes this implies that the adhesive coverage is of a small amount.

Ruppel et al discloses two sheets 5, 6 that are embossed and adhesively 9 bonded. Refer to figures 1 and 4. The height of the embossments is 1-2mm (i.e. 1000-2000 $\mu$ m). The area bonded by the adhesive is disclosed as .1-20% (column 2, lines 19-23).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Donnelly to have the adhesive bond area of less than 30%, as taught by Ruppel, in order to avoid product stiffening and provide a soft feeling tissue therefrom motivated by the fact both references indicate this is a desirable property thereof. With regards to the specific properties of claims 2, 3 and 6, which are all drawn to strength properties of the product Ruppel et al does disclose that it is known that embossing multiply sheets results in improved liquid absorption, touch and softness (column 1, lines 12-18). Therefore, it would have been obvious to one having ordinary skill in the art to vary the strength properties of the product as desired for its particular application (i.e. tissue and or toilet paper) in order to form an improved product therefrom. With regards to claim 5, the sheet caliper would be at least 39-79 mils (1000-2000 $\mu$ m) since the embossments are of this height in Ruppel (column 2, lines 1-65). With regards to claim 7, the sheet can be in roll form per column 3, lines 44-46 disclosing toilet paper of paper towels in Ruppel. With regards to claim 8, the adhesive

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is disclosed in dot form (see column 2, lines 13-65 and column 4, lines 17-30 in Ruppel and column 3, lines 58-60 in Donnelly disclosing small discrete amounts). With regards to claim 9, the prior art plies are conventional fibrous plies.

### ***Response to Arguments***

10. Applicant's arguments filed November 2, 2006 have been fully considered but they are not persuasive. The applicant argues that Donnelly fails to disclose "non-adhesively bonded embossed sites" and "adhesively bonded non-embossed sites" wherein the embossed sites result from the protuberances of one embossing roll engaging the depression of another embossing roll wherein the embossing would form embossment of a different structure than the non-embossed region. The examiner has indicated above which sections in Donnelly equate to the applicant's embossed and non-embossed sites. These recitations are drawn to process limitations, which do not structurally distinguish the claimed product from the prior art. The structure implied by the claim recitations of embossed and non-embossed are that of a ply having alternating projections (i.e. peaks) and valleys. The multiply product being adhesively bonded in the valley and non-adhesively bonded at the peaks. The peaks and valleys actually have the same structure and just project in opposite directions. One could take a single ply from figure 1 and flip it over and the peak would then be the valley and the valley would then be the peak. This is just a matter of semantics whether one calls it an embossment or non-embossment. One could take either ply 12 or 14 in the applicant's figure 1A and flip it upside down and nest it within the other one and it would be the same structure. One could take the entire figure and flip it over and it would be the



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same structure. Also, refer applicant's figure 3 showing ply 14 being embossed by protuberances 46 into ply 12 at 16 with no adhesive and ply 12 being embossed by roll 26 into ply 14 at 20, which is where the adhesive is located. Additionally from figure 3, both the embossed sites 22 (which equate to 16 in applicant's figure 3) and the non-embossed sites 20 are both formed from protuberance from one roll (42 for roll 26 and 46 for roll 34) engaging the depressions of the other roll (44 in roll 26 and the sections between protuberances 46 in roll 34). The applicant argues that there is no motivation for saying the physical limitations in claims 2, 3 and 6 are obvious over the prior art. However, from Ruppel, column 1, lines 12-18, it is taught that improved liquid absorption, touch and softness (column 1, lines 12-18) are desirable properties in the art. All of these properties would be affected by the embossments and the amount of adhesive used to bond the plies. The prior art teaches the percent adhesive coverage recited by the applicant. Therefore, it would have been obvious to one having ordinary skill in the art to vary the strength properties of the product as desired for its particular application (i.e. tissue and or toilet paper) in order to form an improved product therefrom motivated by the fact said properties would be controlled by the embossments and adhesive coverage. One would additionally be motivated to form whatever strength properties are desired for a particular application.

11. The Declaration filed under 37 CFR 1.132 filed November 2, 2006 is insufficient to overcome the rejection of claims 1-9 and 24 based upon 35 USC 102 and 103 as set forth in the last Office action because: The Declaration indicates that an embossed site is structurally distinct from a non-embossed site. However, no specific different structure

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imparted there from, which distinguishes from the prior art, is recited in the claims. The examiner has already indicated what sections of the prior art equate to the applicant's claim structure. Additionally, as indicated above, both the embossed sites 22 (which equate to 16 in applicant's figure 3) and the non-embossed sites 20 are both formed from protuberance from one roll (42 for roll 26 and 46 for roll 34) engaging the depressions of the other roll (44 in roll 26 and the sections between protuberances 46 in roll 34).

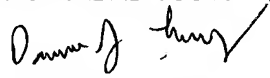
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DJL;D.Loney  
02/01/07

  
Donald Loney  
Primary Examiner  
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